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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,544	02/13/2002	Jeremy John Carroll	30005896-1	8624

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

OSBORNE, MATTHEW C

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/075,544

Applicant(s)

CARROLL ET AL.

Examiner

Matthew Osborne

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This is the first office action on the merits for Application 10/075544.

Claims 1-12 have been examined.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of Claims 2-8 and 10-12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular,

4. Regarding claim 9, the phrase "generally passively monitors" renders the claim indefinite because it is unclear what the standard for measuring the degree of monitoring intended in the invention. See MPEP § 2173.05(b). For the purposes of examination only, the limitation is read as "passively monitors."

5. Regarding claim 10, the phrase "at an early stage" renders the claim indefinite because it is unclear what the standard for measuring the stage of process intended in the invention. See MPEP § 2173.05(b). For the purposes of examination only, the limitation is read as a time prior to any contract terms being agreed to by the parties.

6. Regarding claims 11 and 12, the claims are not sufficiently precise because it is unclear to which statutory class/classes the "service" and "contract manager for a service" are drawn.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8. Claims 11 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are ambiguous as to which intended statutory classes of invention are claimed as set forth in 35 USC 101. The claims begin by discussing a service or contract manager for a service, and subsequently the claim then deals with the specifics of a method (the steps) executed (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7 and 9-12 rejected under 35 U.S.C. 102(b) as being anticipated by Sloo (WO 97/04410).

11. Re Claims 1-7 and 9-10, Sloo discloses:

- [Claim 1] providing a contract manager which monitors communications between the parties relating at least to the contract formation phase of the transaction (see at least Page 1, Lines 5-16),
- the contract manager keeping an auditable record of the negotiation so as maintain an independent record of the agreed contract (see at least Page 1, Lines 11-16).
- [Claim 2] wherein the contract manager maintains an auditable record of each step in the negotiation (see at least Page 4, Lines 12-15).
- [Claim 3] wherein the contract manager maintains an auditable record of at least one of each new contract term proposed, and any change to a previously proposed contract term proposed, and a proposed contract term being agreed, so that the party to the negotiation who made an initial proposal or proposed a modification to a previously proposed contract term, may subsequently be identified (see at least Page 4, Lines 12-15).
- [Claim 4] wherein the contract manager is operated independently of the customer and the vendor (see at least Page 24, Lines 1-2, wherein agreement and payment for the service disclosed shows independency of the service from the parties involved).
- [Claim 5] wherein the parties negotiate using a job ticket format with the job ticket being exchanged between the vendor and the buyer during the contract formation phase of the transaction while the parties make proposals and counter

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proposals for the contract terms (see at least Page 4, Line 27, through Page 5, Line 3).

- [Claim 6] wherein in performance of the method the parties exchange a reference only to the contract being negotiated, along with any fresh proposal or proposal for a modification to any contract term (see at least Page 5, Line 26, through Page 6, Line 2).
- [Claim 7] wherein the contract manager, in addition to monitoring communications between the parties during the contract formation phase of the transaction, monitors communications between the parties relating to the contract execution phase of the transaction, the contract manager keeping an auditable record of such communications so as to maintain an independent record of such communications (see at least Page 4, Lines 1-3).
- [Claim 9] wherein the contract manager is connected to the network and the contract manager passively monitors communications between the parties (see at least Page 1, Lines 5-16).
- [Claim 10] wherein the contract manager is enabled by one or both or only upon agreement of the parties in the contract formation negotiations prior to any contract terms being agreed to by the parties (see at least Page 4, Lines 27-30, wherein the receipt of an offer in the system by one party enables the system).

12. Re Claims 11 and 12, Sloo ('410) discloses the limitations of the corresponding method claim, *supra*.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo ('410) in view of McLauchlin et al. (2001/0011222). Sloo discloses the limitations of Parent Claim 1, *supra*, and the modification of contract terms during formation as mentioned in Claim 3, *supra*. Sloo does not disclose *the event that the parties agree to a change in the negotiated contract during the contract execution phase of the transaction, a record of such change is maintained by the contract manager along with an auditable record of which party proposed and which party agreed to such a change*. However, McLauchlin teaches an integrated procurement management system using a public computer network which provides for the "modification/amendment" of existing procurement contracts (see at least data structure detailed in Figure 3B). Since both Sloo and McLauchlin relate to the recordation and formation of contracts through a computer network, it would therefore be obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Sloo and McLauchlin in order to "provide for vendor [or party] relationship management" (see McLauchlin, Paragraph 21).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Osborne
Examiner
AU 3694

MS


ELLA COLBERT
PRIMARY EXAMINER